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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,857	02/25/2002	Jan Weber	S13.12-0128	6210

7590 05/16/2005

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EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/084,857	Applicant(s) WEBER, JAN	
	Examiner Vy Q. Bui	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10, 13-19, 27 and 30-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 12, 20-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Election/Restrictions*

Claims 9-10, 13-19, 27, 30-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant's election with traverse of the restriction in the reply filed on 7/23/2004 is acknowledged. There is no good ground for traversal. The requirement is deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Garibaldi et al.-6,364,823.

As to claims 1-7 and 20-25, Garibaldi et al.-6,364,823 (col. 7, line 64 to col. 8, line 61; Fig. 10-13) discloses a medical device 120 (can be used as an embolic coil or a stent) having magnetically susceptible material/particles disposed around a core of nitinol 122, an magnetic field B. Notice that beside the heat from a patient body, inherently, magnetic field B will cause

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some heat in the medical device when the medical device is exposed to magnetic field B. The magnetically susceptible material (particles) decreases magnetic susceptibility within a preselected temperature range or Curie point below normal body temperature of 98.6 F (col. 13, lines 9-33).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 11-12, 26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garibaldi et al.-6,364,823.

As to claims 8, 11, 26 and 29, Garibaldi et al.-6,364,823 discloses substantially the invention and core 122 made of a nitinol so that the medical device can open when released from a catheter. Garibaldi-'823 does not explicitly disclose the core 122 made of a magnetically susceptible material. However, Garibaldi-'823 discloses a metal gadolinium (col. 13, lines 9-33) as a magnetically susceptible material. Gadolinium has a high modulus of elasticity (about 76 Gpa) comparable to a nitinol (about 40-75 Gpa). It would be obvious to one of ordinary skill in the art at the time of the invention to substitute nitinol core 122 of the Garibaldi-'823 device by gadolinium core 122 so that the medical device can open when it is released from a catheter.

As to claim 12, Garibaldi et al.-6,364,823 discloses substantially the invention and the magnetically susceptible material being gadolinium or PdNi. Garibaldi et al.-6,364,823 does not disclose FeO (Ferrite Oxide) or CrO (Chromium Oxide) a magnetically susceptible material. However, FeO (Ferrite Oxide) or CrO (Chromium Oxide) are well known magnetically susceptible

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material. It would have been obvious to one of ordinary skill in the art at the time of the invention to use FeO or CrO (Cromium Oxide) as a magnetically susceptible material in place of a gadolinium or a PdNi.


As to claim 28, Garibaldi et al.-6,364,823 does not disclose less than the total core is coated with magnetically susceptible material. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to coat the core less than the total core for this configuration is only a design choice (no criticality).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T Nguyen can be reached on 703-308-2158. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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05/10/2005

Vy Q. Bui  
Primary Examiner  
Art Unit 3731